

REMARKS

The office action and the references cited therein have been carefully considered together with the present application and claims 39, 45 and 47 have been amended to correct the deficiencies pointed out in the examiner's 112 rejection of these claims. It is noted that the examiner indicated that claim 39 would be allowable if rewritten to overcome the 112 rejection. Because it is believed that this has been done, reconsideration and allowance of claim 39 is respectfully requested.

With regard to the rejection of claims 32, 33, 39 and 44-48, those rejections are respectfully traversed for the reasons set forth below. The examiner has rejected claims 32 and 44 under 35 U.S.C. 103(a) as being unpatentable over Tomayko in view of Long, contending that Tomayko meets the elements of the claim, but admits that Tomayko does not disclose the handles to be attached to the motor housing. Instead, the examiner contends that "it would be obvious at the time of the invention to one of ordinary skill in the art to rearrange Tomayko such that the handles were attached to the motor housing because rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. (CCPA 1950)"

This rejection is absurd. *In re Japikse*, 86 USPQ 70, which is a 1950 CCPA decision does not even begin to correctly state the law of obviousness that has evolved in the last 55 years, particularly since the establishment of the Court of Appeals for the Federal Circuit. *In re Japikse*, is not found to have ever been cited by a federal district court in a patent case or in the Court of Appeals for the Federal Circuit in any

appeal, and the examiner's reliance upon this case is totally misplaced. In fact, in subsequent decisions, the Board of Patent Applications and Interferences, has criticized the decision. For example, in *Ex Parte Boris E. Makutonin, Frank G. Oliverio And Matthew J. Zdinak*, (unpublished) the Board stated: In the present case, the examiner fails to advance any factual basis to supply the admitted deficiencies of Scarpa vis-a-vis the subject matter recited in independent claims 1, 16, 24, 35 and 36. Instead, the examiner attempts to bridge Scarpa's evidentiary gaps by resort to so-called mechanical or per se rules of obviousness allegedly established by the *St. Regis* and *Japikse* cases. Such rules do not exist, however, and the reliance thereon by the examiner to establish obviousness under section 103(a) is improper. See *In re Ochiai*, 71 F.3d 1565, 1570, 37 USPQ2d 1127, 1132 (Fed. Cir. 1995); *In re Wright*, 343 F.2d 761, 769-70, 145 USPQ 182, 190 (CCPA 1965).

Also in *Ex Parte Stuardo A. Robles, Thanh Pham And Bang C. Nguyen*, (unpublished) the board stated: "The examiner cites *In re Japikse*, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) for the general proposition that "a mere shifting the location of parts" of an apparatus is a matter of obviousness for the skilled artisan (page 4 of Answer). However, our review of the case reveals no such proposition or rule of law."

A more accurate statement of the law of obviousness is set forth in the following cases. Each prior art reference must be viewed in its entirely and the Court cannot ignore portions that argue against obviousness. *Bausch & Lomb, Inc. v. Barnes-*

Hind Hydrocurve, Inc., 796 F.2d 443, 448 (Fed. Cir. 1986), citing *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1550 (Fed. Cir. 1983).

As this court has stated, virtually all [inventions] are combinations of old elements. *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 875, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 159-80, 219 USPQ 8, 12 (Fed. Cir. 1983) (Most, if not all, inventions are combinations and mostly of old elements.). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be an illogical and inappropriate process by which to determine patentability. *Sensonics, Inc. v. Aerasonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996). *In re Denis Rouffet, Yannick Tanguy and Frederic Berthault*, (Fed. Cir. 1998).

It is recognized by those skilled in the art of routers that there are important differences between plunge routers and fixed base routers, as well as hybrid routers which have a common motor unit that can be inserted into a fixed base as well as a plunge router base. The present application is directed to a hybrid router. If the examiner performs a Google or similar search on hybrid or combination routers, it is clearly

evident that there are many manufacturers in the tool business that sell such hybrid routers. No hybrid router products have been located by such a search conducted by the undersigned which have handles attached to anything other than the plunge base and fixed base part of the combination. Stated in other words, none of the hybrid routers that have been located have ever had a removable motor assembly where the operating handles are attached to the motor assembly housing.

It simply has not been done and given the fact that routers have been around for decades, the examiner's simplistic conclusory assertion that it would have been obvious to rearrange Tomayko such that the handles were attached to the motor housing certainly rings hollow and cannot be reconciled with the history of development of such tools through the decades. When Tomayko is carefully examined, it is not known how it would be modified too easily to put the handles on the motor unit. Since the motor unit screws into the fixed base, there are all kinds of design implications that would be raised.

Equally if not more importantly, there is no suggestion or motivation in Tomayko to have make such a modification. Long does not supply the deficiencies of Tomayko either. Moreover, Long is a plunge router rather than a fixed base router and it does not have a motor assembly that can be removed from such a fixed base assembly, nor is it capable of being removed from a plunge base assembly. It is just a conventional plunge router that has very little relevance to the invention claimed in claim 32. For the examiner to state that Long's plunge router teaches or suggests the elements of claim 32

mischaracterizes of the teachings of the Long patent. The fact that Long states that the handles of the present invention can also be used on a fixed base style router is believed to be irrelevant to the general teachings of Long. It is clear that Long emphasizes the nuances of the shape of his handles, as shown and described in terms of the dimensions Z, L, R and D as well as the angle α (see FIGS 2 and 5). This special and well defined configuration provides the context for the examiner's citation that "The handles of the present invention can also be used on a fixed base style router". What that means is that handles of that same shape could be used with a fixed base router. There is no disclosure whatsoever that these handles are attached to a motor assembly that can be removably installed in either a fixed base assembly or a plunge base assembly. To contend otherwise is a mischaracterization and total distortion of the Long patent.

The comments that have been made with regard to Tomayko and Long with regard to claim 32 equally apply to claim 44.

With regard to claim 46 which has been rejected under 35 U.S.C. 103(a) as being unpatentable over Pientka in view of Long, this rejection is also respectfully traversed. Claim 46 claims a motor assembly that is capable of being removably installed in a fixed base and operate as a fixed base router or is capable of being removably installed in a plunge base and operate as a plunge router, with the motor assembly comprising a housing as recited as well as operating handles attached to the housing. Pientka simply does not teach or suggest this construction, nor do any of the other patents of record.. The examiner again misrepresents the teachings of Long and it is clear that

the handles of Pienta are not attached to motor assembly, but are attached to the base 12. Reconsideration and allowance of this claim is respectfully requested.

Since the dependent claims necessarily include the features of the claims from which they depend and in addition recite additional features or functionalities not found in those claims, it is believed that all dependent claims that are presently pending in the application are also in condition for immediate allowance.

For the foregoing reasons, reconsideration and allowance of all claims that are pending in the application is respectfully requested.

Respectfully submitted,

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